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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/063,990

05/31/2002

Scott Wolmuth

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7590

11/09/2006

EXAMINER

NGUYEN, QUYNH H

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ART UNIT

PAPER NUMBER

2614

DATE MAILED: 11/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/063,990	Applicant(s) WOLMUTH, SCOTT	
	Examiner Quynh H. Nguyen	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-28 and 34-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-28 and 34-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 8/24/06 has been entered. Claims have been amended. Claims 56-91 have been added. Claims 23-28 and 34-91 are still pending in this application, with claims 23, 34, 57, and 63 being independent.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 8/24/06 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
4. Declaration of Scott Wolmuth under 37 CFR 1.132 filed 10/12/05 was received and considered.
5. Applicant is reminded to cancel claims 17-22 and 29-33 instead of withdraw.

Claim Objections

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6. Claim 57 is objected to because of the following informalities: the preamble recites "A machine-accessible medium containing instructions that, when executed, cause a machine to:" is not clearly define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. Suggestion for the preamble of claim 57 is -
- A computer readable medium encoded with computer executable instructions to: --.
Failure to correct the above may lead to a 35 USC 101 rejection. Appropriate correction is required.

Claim 64 line 4 recites "...to transmit **athe** request for directory assistance information received from the user" should be -- ...to transmit **the** request for directory assistance information received from the user --. Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. Claims 23, 45-47, 51, 59-61, 75-77, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Patent 6,970,548) in view of Solomon et al. (U.S. Patent 5,361,295).

As to claim 23, Pines et al. teaches a method comprising:

requesting directory assistance for a selected number by a user (*Requester 4*), the selected number being associated with a specific provider of goods or services (*restaurant, movie*) (col. 14, lines 45-67);

using the selected number for the specific provider of goods or services to automatically select a selected advertisement from an advertising database (*Listing Table 52A and Database 18*) (col. 14, lines 60-67);

presenting the selected advertisement to the user (col. 10, lines 1-7; col. 12, lines 42-46).

Pines et al. do not teach asking the user if he or she want to be connected to an advertised provider associated with said selected advertisement, and connecting said user to the advertised provider if the user agrees to be connected to the advertised provider.

Solomon et al. teaches asking the user if he or she want to be connected to an advertised provider if the user agrees connecting the user to the advertiser (col. 16, lines 39-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Solomon into the teachings of Pines thus making the system more efficient and user-friendly by only connecting the user to the advertised provider according the user's wishes, otherwise providing the user with their selected number in order to prevent the user from having to listen to unwanted advertisements.

As to claims 45, 59, and 75, Solomon et al. teaches providing access to a service associated with the selected advertisement (col. 16, lines 39-50).

As to claims 46-47, 51, 60-61, 76-77, and 81, Solomon et al. teaches prompting the user of the customer station to select and connecting the customer station to a telephone number associated with the selected advertisement (col. 16, lines 39-50).

8. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Patent 6,970,548) in view of Solomon et al. (U.S. Patent 5,361,295) and further in view of Gregorek et al. (U.S. Patent 5,557,658).

Claims 58 and 73-74 are rejected under 35 U.S.C 103(a) as being unpatentable over Pines et al. (U.S. Patent 6,970,548) in view of Gregorek et al. (U.S. Patent 5,557,658).

As to claim 25, Pines and Solomon do not teach the selection a criterion is based on the user's geographical location.

Gregorek et al. teaches the selection a criterion is based on the user's geographical location (col. 9, lines 17-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Gregorek into the teachings of Pines and Solomon for the purposes of playing the appropriate advertisement according user's geographical location. For example, if the user were in Philadelphia, the user would like to know the local weather of Philadelphia instead of the weather of where the user came from.

As to claims 26 and 73, Gregorek et al. teach the selection criteria is based on the user's phone number (col. 9, lines 12-17).

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As to claim 27, Pines et al. teach advertisements are stored in a memory means (col. 14, lines 43-45).

As to claim 28, Pines et al. teach the user is requesting directory assistance and toll services (col. 10, lines 42-50; col. 14, lines 40-52).

Claims 58 and 74 are rejected for the same reasons as discussed above with respect to claims 25-26.

9. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Patent 6,970,548) in view of Solomon et al. (U.S. Patent 5,361,295) further in view of Swix et al. (U.S. Patent 6,718,551).

As to claim 24, Pines and Solomon do not teach the selection a criterion is based on Standard Industry codes.

Swix et al. teaches selection a criterion is based on Standard Industry codes (col. 3, lines 3-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the standard industry codes as being one of the section criteria, as taught by Swix, in Pines' and Solomon's systems which indicate such user characteristics as employer and type of employer in order to deliver pertinent advertisements that the user would be interested in, as discussed by Swix (col. 3, lines 19-23).

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10. Claims 49, 79, 87, and 90 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Patent 6,970,548)

As to claims 49 and 79, Pines does not teach returning an optional intercept parameter used to determine whether the user of the customer station is to be prompted to request access to a service associated with the advertisement associated with the selected advertisement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the above-mentioned teachings into Pines' system thus making the system more efficient and user-friendly.

As to claim 87, in Applicant's own specification (page 3, [0015]), Applicant only stated, "press 1 to be transferred to (the advertiser) now" and did not mention about if the user does not agrees connect the user to their selected number. Therefore, Examiner would treat the limitation "if the user does not agrees connect the user to their selected number" as a default case as if the user does not agrees.

As to claim 90, Applicant recites the language one of listen and not to listen to the advertisement. Examiner interprets this claim as s user chooses not to listen to the advertisement and the claim is rejected for the same reasons as discussed above with respect to claim 87.

11. Claims 36, 43-44, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Patent 6,970,548) in view of Gregorek et al. (U.S. Patent 5,557,658).

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Claims 36, 44, and 67 are rejected for the same reasons as discussed above with respect to claim 25.

As to claim 43, Gregorek et al. teaches causing the advertisement to be played to the customer station in a visual format (col. 2, lines 22-29).

12. Claims 40-41, 55, 70-71, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Patent 6,970,548) in view of Swix et al. (U.S. Patent 6,718,551).

Claim 40-41, 55, 70-71, and 85 are rejected for the same reasons as discussed above with respect to claim 24.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 34-35, 37-39, 42, 48, 50, 52-54, 56-57, 62-66, 68-69, 72, 78, 80, 82-84, 86, 88-89, and 91 are rejected under 35 U.S.C. 102(e) as being anticipated by Pines et al. (U.S. Patent 6,970,548).

As to claims 34 and 63-65, Pines et al. teaches the steps of: at the customer station (Fig. 1, 4), a user input device (col. 6, lines 30-32) for dialing a telephone number used for accessing the call processing station, and a call connection circuitry (col. 8, line 65 through col. 9, line 4 - *circuitry in switch 12*) operates for setting up a call connection from the customer station (Fig. 1, 4) to the call processing station (col. 7, lines 52-67; col. 8, line 65 through col. 9, line 4); providing a request for information relating to a telephone number for a specific provider of goods or services (*restaurant, movie*) (col. 14, lines 45-67); at the call processing station (col. 8, line 65 through col. 9, line 4), receiving the request for information from the customer station (col. 14, lines 45-67); examining the request for information to identify a subject matter area associated with the specific provider of goods or services and automatically selecting an advertisement categorized within the subject matter area (*Listing Table 52A and Database 18*) (col. 14, lines 60-67); a processor (*processor in System 2*) that operates for receiving the selected advertisement from a stored media and forwarding the selected advertisement to the customer station; and at the customer station (col. 14, lines 44-67), receiving the selected advertisement (col. 10, lines 1-7; col. 12, lines 42-46).

As to claims 35 and 66, Pines et al. teaches querying a database using as at least one query parameter to determine the selected advertisement (col. 12, lines 51-67; col. 14, lines 30-34).

As to claims 37-39 and 68-69, Pines et al. teaches the query parameter is a name of a business, general type of business, a product or service specific provider of

goods or services in the request for information (12, lines 51-67; col. 14, lines 30-34- *for example, restaurant, movie, etc.*).

As to claims 42 and 72, Pines et al. teaches causing the advertisement to be played to the customer station in an audible format (col. 12, lines 42-50).

Claims 48, 50, 78, and 80 are rejected for the same reasons as discussed above with respect to claims 35 and limitation e of claim 34.

As to claims 52-53, 62, and 82-83, Pines et al. teaches providing a reduced cost as compared to a standard cost for a request for directory information associated with a telecommunication service provider or without cost to the user (col. 10, lines 47-50).

As to claims 54 and 84, Pines et al. teaches querying parameter is the telephone number associated with the request for information (col. 8, line 65 through col. 9, line 4 and col. 10, lines 1-7).

As to claims 56 and 86, Pines et al. teaches the request for information relating to a telephone number for a specific provider of goods or services does not inherently determine the subject matter area (col. 4, lines 7-15).

Claim 57 is rejected for the same reasons as discussed above with respect to claim 34. Furthermore, Pines et al. teaches a computer readable medium (Fig. 1; col. 6, lines 34-60).

As to claim 88, Pines et al. teaches an apparatus comprising: a selection means operates to select an advertisement from a plurality of advertisements to one of play and display on an external device (col. 14, lines 30-42); a memory coupled to the

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selection means, the memory to store the plurality of advertisements (col. 14, lines 30-45), wherein the advertisement is selected based on a toll free directory assistance request for a telephone number associated with a provider of one of goods and services (col. 14, lines 53-65 and col. 10, lines 47-50), and the advertisement is targeted to one of the goods and the services (col. 14, lines 61-65).

As to claim 89, Pines et al. teaches the telephone number is requested through directory assistance (col. 14, lines 45-47).

As to claim 91, Pines et al. teaches the external device is one of a telephone, a cellular telephone, an Internet telephone and a handheld computer device (col. 14, lines 34-36 - *where Pines discussed an announcement plays to Requester 4*; col. 6, lines 6-13 - *where Pines discussed Requester 4 access System 2 via cellular telephone, PDA, PCS phone via a wireless carrier*).

Response to Arguments

15. Applicant's arguments with respect to claims 23-28 and 34-55 have been considered but are moot in view of the new ground(s) of rejection. New claims 55-91 are also considered. Applicant's arguments are addressed in the above claims rejections.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

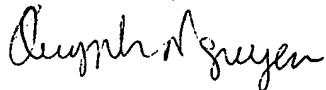
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Monday - Thursday from 6:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan, can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read "Quynh H. Nguyen".

Quynh H. Nguyen

November 8, 2006